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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,252	03/08/2001	Makoto Ono	JP920000032US1 (590.050)	5562
35195 7590 02/27/2007 FERENCE & ASSOCIATES 409 BROAD STREET PITTSBURGH, PA 15143			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2143	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 02/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/802,252

Applicant(s)

ONO, MAKOTO

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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#### DETAILED ACTION

Claims 1-4, 6, and 7 are currently presented and have been examined.

#### *Response to Arguments*

Applicant's arguments filed 10 January 2007 have been fully considered but they are not persuasive.

The Applicant argues that Park does not teach or suggest generating a license key at a user's information terminal. The Examiner respectfully finds this argument to be unpersuasive in view of the teachings and suggestions of Park.

MPEP 2123 states:

"A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.)"

Park discloses:

"...a connection between a user and said software registration system which provides the software registration server with user registration, hardware registration, and software registration, the software registration [server] creating a license file based on these registrations." (column 2, lines 44-49)

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"When the user begins registration, the user gets a partial user-ID file from the software registration server. After receiving the partial user-ID file, the user's software license control program attaches a public/secret key pair of the user and the public key of the registration server of the user to the partial user-ID file." (column 3, lines 47-52)

"Thus, in accordance with the present invention, software license control may be realized using an independent software registration server including creating secret/public key pair for a user by the user software license control program on the user computer." (column 4, lines 32-36)

"The user is registered to the software registration server once per person and receives a partial user-ID file from the software registration server. The user software license control program attaches the user secret/public key pair and the public key of the user's software registration server to the partial user-ID file that includes user information encrypted by user public key and is digitally signed by the server secret key." (column 4, lines 46-54)

In view of these teachings within Park, while Park does not expressly teach generating a license file at the user information terminal, Park does teach generating information in two different contexts and wherein the server generates the

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license key. Since the claim fails to specifically recite any particular methods of generating the license key aside from using a broadly recited "information" to generate the key, these teachings within Park would have reasonably suggested to one of ordinary skill that, since the user's information terminal is capable of generating information and that the server generates the license key, a alternative nonpreferred embodiment wherein the user's information terminal is able to generate the license key would have been possible. Therefore, Park does reasonably suggest wherein the user's information terminal generates the license key and, therefore, Park does anticipate this limitation in accordance with MPEP 2123.

The Applicant also argues that Park does not teach generation of a new license key. However, Park does disclose that the license key may expire or require refreshing (see at least column 5, lines 31-33). Therefore, Park does disclose this limitation.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,260,141 B1 to Park.

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Regarding claim 1, Park discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

downloading a program from a server managed by said network provider, or by an entity that has a tie-up with said network provider; (column 4, line 66-column 5, line 5)

transmitting, to said information terminal of said user, information with which a license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches another predetermined license condition can be generated at said information terminal of said user; (column 3, lines 44-46; column 3, lines 55-61; column 4, lines 56-59; column 5, lines 6-13)

and transmitting, to said information terminal of said user after reconnecting to the server, information with which a new license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches another predetermined license condition can be generated at said information terminal of said user. (column 3, lines 44-46; column 3, lines 55-64; column 5, lines 30-34)

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Park does not expressly disclose wherein a user, who uses a network via a network provider under a condition of payment of a connection fee, transmitting a connection request from an information terminal of said user to said network provider that includes a user ID from an information terminal of said user to said network provider, however, the Applicant has admitted that this subject matter was well known in the art at the time the invention was made by failing to seasonably traverse the Examiner's Official Notice. Therefore, it would have been obvious to one of ordinary skill in the art to include this well known subject matter with the teachings of Park since it was within the level and knowledge of one of ordinary skill to transmit a connection request that includes a user ID from an information terminal of said user to said network provider.

Claims 4 and 6-7 are also rejected since claims 4-7 recite an information distribution method, software product, and program storage device that recite substantially the same limitations as recited in claim 1.

Regarding claim 2, Park discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

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transmitting a service menu screen, which is an initial screen, from said network provider to said information terminal of said user; transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; transmitting, when said file server receives said connection request, to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading service menu; (column 3, line 65-column 4, line 2)

determining whether a program key, uniquely identifying a program type at said network provider, is present at said information terminal, and where said program key is not found to be present, transmitting, when said user selects the downloading of a desired file from said service menu, a file downloading request from said information terminal of said user to said network provider; (column 4, lines 2-4)

generating a license key, based on specified downloaded program information, that is associated with said desired file that is selected by said user and with a user ID included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a



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license condition for a downloaded program; (column 3, lines 47-57; column 4, line 33-64)

downloading to said information terminal said license key, said program key, and said selected program file, said program file being capable of referring to said downloaded license key when said downloaded program is activated or executed, and capable of disabling at least a part of the function of said downloaded program, when said program matches a predetermined said licensing condition provided by reference (column 3, lines 44-46; column 3, lines 55-61; column 4, lines 56-59; column 5, lines 6-13);

transmitting said downloaded program specifying information from said information terminal of said user to said network provider; based on said user ID and said received downloaded program specifying information generating information from which a new license key can be generated; and transmitting said new license key to said information terminal of said user said information from which a new license key can be generated and generating a new license key at said information terminal of the user. (column 3, lines 44-46; column 3, lines 55-64; column 5, lines 30-34)

Park does not expressly disclose wherein a user, who obtains a user ID and a password and employs a network via a

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network provider under a condition of payment of a connection fee, activating a dialer at said information terminal, entering said user ID, said password and a telephone number for accessing said network provider, and transmitting a connection request to said network provider; checking, upon the receipt of said connection request for said network provider, said user ID and said password that are included in said connection request; transmitting, when the results obtained by the check are negative, a message used to notify said user of a connection failure; assigning, when the results obtained by the check are affirmative, an IP address to said information terminal of said user, and registering a set consisting of said user ID and said correlated IP address; transmitting said IP address assigned for said information terminal of said user; and disconnecting said information terminal of said user from said network provider.

However, this subject matter was admitted by the Applicant and therefore it would have been within the level and knowledge of one of ordinary skill in the art at the time the invention was made to perform these steps in order to use a modem in order to remotely connect to a server in order to effect connecting to the Internet as is conventionally known in the art.

Regarding claim 3, Park discloses an information distribution method for transmitting information to an

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information terminal connected via a network, comprising the steps of:

transmitting a service menu screen, which is an initial screen, from said network provider to said information terminal of said user; transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; transmitting, when said file server receives said connection request, to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading service menu; (column 3, line 65-column 4, line 2)

determining whether a program key, uniquely identifying a program type at said network provider, is present at said information terminal, and where said program key is not found to be presented, transmitting, when said user selects the downloading of a desired file from said file downloading service menu, a file downloading request from said information terminal of said user to said network provider; (column 4, lines 2-4)

registering a user ID and said downloaded program specifying information with which said user ID is correlated; generating a license key, based on specified downloaded program information, that is associated with said desired file that is

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selected by said user and with a user ID included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a license condition for a downloaded program; (column 3, lines 47-57; column 4, line 33-64)

downloading to said information terminal said license key, said program key, and said selected program file, said program file being capable of referring to said downloaded license key when said downloaded program is activated or executed, and capable of disabling at least a part of the function of said downloaded program, when said program matches a predetermined said licensing condition provided by reference (column 3, lines 44-46; column 3, lines 55-61; column 4, lines 56-59; column 5, lines 6-13)

searching for said downloaded program specifying information that is registered while correlated with said user ID; based on said user ID and said received downloaded program specifying information generating information from which a new license key can be generated; and transmitting said new license key to said information terminal of said user said information from which a new license key can be generated and generating a new license key at said information terminal of the user.

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(column 3, lines 44-46; column 3, lines 55-64; column 5, lines 30-34)

Park does not expressly disclose wherein a user, who obtains a user ID and a password and employs a network via a network provider under a condition of payment of a connection fee, activating a dialer at said information terminal, entering said user ID, said password and a telephone number for accessing said network provider, and transmitting a connection request to said network provider; checking, upon the receipt of said connection request for said network provider, said user ID and said password that are included in said connection request; transmitting, when the results obtained by the check are negative, a message used to notify said user of a connection failure; assigning, when the results obtained by the check are affirmative, an IP address to said information terminal of said user, and registering a set consisting of said user ID and said correlated IP address; transmitting said IP address assigned for said information terminal of said user; and disconnecting said information terminal of said user from said network provider, however, this subject matter was admitted by the Applicant and therefore it would have been within the level and knowledge of one of ordinary skill in the art at the time the invention was made to perform these steps in order to use a modem in order to

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remotely connect to a server in order to effect connecting to the Internet as is conventionally known in the art.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/gcn/



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